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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/466,947	12/20/1999	DALE D. PETERSON	55288USA1A	1762

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EXAMINER

LEWIS, RALPH A

ART UNIT	PAPER NUMBER
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3732

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DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/466,947

Applicant(s)

PETERSON, DALE D.

Examiner

Ralph A. Lewis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8, 12-19, 21-24 and 26-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 6-8, 12-14, 16-19, 21-24 and 26-32 is/are allowed.
- 6) ☒ Claim(s) 15 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### **Rejections based on Prior Art**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duis et al (6,054,090).

Duis et al disclose product containers 112 (apparently 12 in Fig 4) for containing contact lenses. The containers have a body having an exterior surface of a certain color. The Duis et al product containers 112 include a wall forming a label 130 (or 30) that is made of multiple layers of polymers of contrasting colors (note abstract). The inner layer(s) is interpreted as part of the claimed "exterior surface" and the outer layer(s) is interpreted as the claimed "polymer coating." A laser is used to ablate an outer layer to provide a "product-variable indicia such as a lot number and expiration date" (column 3, lines 28- 34). The laser engraved lot number and expiration date meet applicant's claimed "species mark" limitation. In the discussion of the prior art, Duis et al indicates that in addition to the product variable-indicia there is typically unchanging indicia such as brand names (note column 1, lines 10-20). Duis et al does not explicitly state that the containers 112 also contain unchanging indicia (e.g. brand names), however, one of ordinary skill in the art, in view of the earlier disclosure regarding the

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prior art, would have found it obvious to have provided the label 130 with an unchanging indicia (e.g. brand name) so that the consumer can be made aware of the product in the container. Moreover, it has long been recognized that the color of product packaging itself is useful as a trademark indicator to signal to the consumer a particular brand or product (e.g. sweetener packaging (white sugar, brown raw sugar, blue Equal, pink Sweet 'N Low), dry-cleaning pads (*Qualitex*, 115 S.Ct. 1300), yellow packaging Kodak film, different colors for different flavors of Wrigley's brand gum, etc. etc. etc.). To have merely used different colors on the packaging of the Duis et al contact lens packages in order to signify to the consumer different brands of contact lens and different types (daily wear, extended wear, colored etc.) would have been obvious to one of ordinary skill in the art as a matter of routine marketing of the product.

**Allowable Subject Matter**

Claims 1-4, 6-8, 12-14, 16-19, 21-14 and 26-31 are allowed.

Claim 33 is objected to as being dependent on a rejected based claim but would be allowable if rewritten in independent form to include all of the limitations of the claims from which it depends.

**Action Made Final**


**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Ralph Lewis at telephone number (703) 308-0770. Fax (703) 872-9306. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (703) 308-2582.

R.Lewis  
February 23, 2004

  
Ralph A. Lewis  
Primary Examiner  
Au 3732